

### REMARKS

Reconsideration of the outstanding Office Action is respectfully solicited.

Applicants note the withdrawal of Claim 24 by the U.S. Patent & Trademark Office based on the allegation that the subject matter thereof is directed to a non-elected invention. Claim 24 has been canceled; but applicants reserve the right to file a divisional application based thereon.

Applicants respectfully traverse the rejections of the claims over Endo, U.S. 5,707,836.

The Endo written description differs from the description and Claims of this application. As recited in the pending Claim 21 directed to *Arthrobacter* FERM BP-6444, an essential feature of *Arthrobacter* FERM BP-6444 lies in the activity for decomposing a polyester containing an aromatic moiety.

On the other hand, the method described in Endo et al. (including *Arthrobacter* Strain KK-3) is directed to production of an optically active amino acid. As described in Endo et al (for example in Claim 1), such method is achieved by using microorganisms having lyase activity and being capable of producing the optically active amino acid. Therefore, *Arthrobacter* Strain KK-3 has enzymatic activity as a lyase, which is also described in EXAMPLE 2 of Endo et al.

Notwithstanding those differences, it appears to be the Examiner's position that the difference in the descriptions is simply verbiage or semantics, as to both the identity of the microorganisms and as to their application. The Examiner cites In re Best, and

indicates that the burden is on the applicant(s) to show that the two organisms are in fact different.

Applicants filed Dr. Oda's DECLARATION on October 12, 2004. The DECLARATION establishes that there are two differences between the microorganisms of the rejected claims and the Endo reference. The DECLARATION relates to properties of Mobility[motility] and to an analysis, a 16S rDNA-500 Base Sequence Analysis. Applicants obtained Arthrobacter Strain KK-3 according to Endo et al (FERM BP-5414) from Japanese Authorized Depositary Organization, and compared its characteristic with that of FERM BP-6444 (the strain according to present specification).

### **Motility**

The inventors compared mobility of the two strains by the means of microscopic observation. FERM BP-6444 showed mobility, which is consistent with description in page 9 of present specification. By comparison, Arthrobacter Strain KK-3 did not exhibit motility, as described in page 3 of Endo et al. Therefore, the two strains exhibited different motility characteristics.

### **16S rDNA-500 base sequence analysis**

The inventors assigned the sequence analysis to an external institute (NCIMB Japan CO., LTD) to ensure fairness and accuracy of the experimental data. The sequence alignment was attached to the DECLARATION as Enclosure 1. As shown in the sequence data, the result of the 16S rDNA-500 base sequence analysis exhibited 89.15% of homology between the two strains (Arthrobacter Strain KK-3 and FERM BP-6444).

Dr. ODA, in his DECLARATION, further states,

According to the 16S rDNA-500 base sequence analysis, it is generally recognized that two strains exhibiting homology of higher than 97% may possibly be identical. However, as the sequence homology was 89.15% and did not exhibit such high homology, the two strains are not considered to be identical. In other words, according to this analysis, it is suggested that the two strains are taxonomically different. Also attached hereto is a literature reference relating to the 16S rDNA-500 base sequence analysis [E.Stackebrandt et al., International Journal of Systematic and Evolutionary Microbiology (2002) 52 p1043-1047].

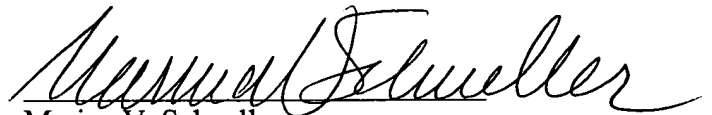
[Declaration at page 2]

In applicants' view, the two differences concerning the microorganisms distinguishes them, one from the other.

Accordingly, an early allowance is respectfully solicited.

Respectfully submitted,

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